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Leon E. Redman
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EXAMINER

CASCHERA, ANTONIO A

ART UNIT	PAPER NUMBER
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2628

MAIL DATE	DELIVERY MODE
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03/06/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/748,953

Applicant(s)

RICE, MARY ROSE

Examiner

Antonio A. Caschera

Art Unit

2628

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 8, 10, 12-15 and 45-77 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 8, 10, 12-15, 50-53 and 57-66 is/are allowed.
- 6) ☒ Claim(s) 1-6, 45-49, 54-56 and 67-77 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 November 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

1. Claims 1-6, 45-49, 54-56 and 67-77 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim(s) 1-6, 45-49, 54-56 and 67-77 is/are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. Supreme Court precedent¹ and recent Federal Circuit decisions² indicate that a statutory “process” under 35 U.S.C. 101 must (1) be tied to another statutory category (such as a particular apparatus), or (2) transform underlying subject matter (such as an article or material) to a different state or thing. While the instant claim(s) recite a series of steps or acts to be performed, the claim(s) neither transform underlying subject matter nor positively tie to another statutory category that accomplishes the claimed method steps, and therefore do not qualify as a statutory process. For example, at least the arranging step of the claims is not explicitly recited as tied to another statutory category.

Response to Arguments

2. The addition of claims 67-77 is noted.

¹ *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

² *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

3. Applicant's arguments, see page 13 of Applicant's Remarks, filed 01/15/09, with respect to the objections of claims 1, 4 and 45 have been fully considered and are persuasive. The objections of these claims have been withdrawn since informalities have been corrected for.
4. Applicant's arguments, see page 13 of Applicant's Remarks, filed 01/15/09, with respect to the 35 USC 112 rejection of claims 8, 10 and 45-49 have been fully considered and are persuasive. The 35 USC 112 rejection of such claims has been withdrawn since informalities have been corrected for.
5. Applicant's arguments filed 01/15/09 have been fully considered but they are not persuasive.

In reference to claims 45-49, Applicant argues the 35 USC 101 rejection and makes amendments to claim 45 to remedy the 35 USC 101 issue (see page 13 of Applicant's Remarks). The Examiner indicates that such amendments are, at this time, not sufficient to overcome the 35 USC 101 rejection. Again, at least one claimed step or element of the method type claim must be either tied to another statutory category (such as a particular apparatus), or (2) transform underlying subject matter (such as an article or material) to a different state or thing. Therefore, the Examiner maintains this rejection and further has included all of the claims of method type suffering from this 35 USC 101 issue, in the above rejection as well.

Allowable Subject Matter

6. Claims 8, 10, 12-15, 50-53 and 57-66 are allowed.

The following is a statement of reasons for the indication of allowable subject matter:

In reference to claims 8 and 12, the prior art of record does not explicitly disclose arranging a first plurality of physical paint sample cards on a display unit so that they are arranged in groups of varying hue in a first direction and chroma in a second direction while further arranging one or more combination or coordination paint sample cards adjacent each group of different hue and chroma physical paint sample cards, each color combination or coordination paint sample card containing a plurality of paint samples having the same base hue as the hue of a group it is adjacent to with a picture of a building or room painted with the plurality of colors on the color combination paint sample card, in combination with the further limitations of claims 8 and 12 respectively.

In reference to claims 10 and 13-15, 57-59, claims 10 and 13-15, 57-59 depend upon allowable claims 8 and 12 respectively and are therefore also deemed allowable.

In reference to claim 50, the prior art of record does not explicitly disclose a first plurality of paint sample cards arranged in hue groups, arranging one or more color combination style cards adjacent to each group of different hue, each combination card having a tri-fold card with three separate sections, each section containing a plurality of paint samples and a picture of a room painted with the plurality of paint samples on the section, each section of the tri-fold card having a picture of a different room, in combination with the further limitations of claim 50.

In reference to claims 51-53, claims 51-53 depend upon allowable claim 50 and are therefore also deemed allowable.

In reference to claim 60, the prior art of record does not explicitly disclose a first plurality of physical color combination cards including a plurality of paint samples which includes at least a base hue sample and a plurality of complementary color samples arranged adjacent to the base

hue sample and having a picture a room or building that is painted with the plurality of paint samples, in combination with the further limitations of claim 60.

In reference to claims 61-66, claims 61-66 depend upon allowable claim 60 and are therefore also deemed allowable.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Antonio Caschera whose telephone number is (571) 272-7781. The examiner can normally be reached Monday-Thursday and alternate Fridays between 7:00 AM and 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kee Tung, can be reached at (571) 272-7794.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

571-273-8300 (Central Fax)

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (571) 272-2600.

Application/Control Number: 10/748,953

Page 6

Art Unit: 2628

/Antonio A Caschera/

Primary Examiner, Art Unit 2628

3/6/09